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REMARKS

This Reply is in response to the Office Action mailed on March 3, 2006 in which Claims 1-35 were rejected. With this response, claims 9, 17 and 24 are canceled with their limitations incorporated into claims 8, 14 and 20, respectively and claims 1, 8, 10-14, 21 and 32 are amended. Claims 1-8, 10-16, 18-23 and 25-35, as amended, overcome the rejections and are presented for reconsideration and allowance.

I. Request for Withdrawal of Finality of Office Action

Page 7 of the Office Action indicated that the action was made final. Applicants respectfully request that the finality of the Office Action be withdrawn since: (1) the Office Action fails to address several of Applicants' arguments and (2) the Office Action relies upon new grounds of rejection NOT necessitated by Applicants' amendment.

A. The Office Action Fails to Address Several of Applicants' Arguments

37 CFR 1.104(b) states that "the Examiner's action will be complete as to all matters." In setting forth the requirements for a Final Rejection, MPEP 706.07 indicates that a final rejection "should include a rebuttal of any arguments raised in the applicants reply." In the present case, the Office Action rejects several of the same claims entirely relying upon the same arguments raised in the previous Office Action without any rebuttal or response to points raised by Applicants in the last Reply regarding such misplaced reliance.

Applicants' last reply traversed the rejection of claims 4, 11, 14, 21 and 29 (see section I.C. of the last reply); claims 5, 12, 20 and 25 (see section I.D. of the last reply); claim 7 (see section I.E. of the last reply); claim 27 (see section I.F. of the last reply); claim 31 (see section I.G. of the last reply); and claim 34 (see section I.H. of the last reply). However, the final Office Action fails to even address such traversals. In contrast, the Office Action appears to have simply cut and paste the

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same exact basis from the last Office Action into the final Office Action. Because the Office Action has failed to include any rebuttal of Applicants arguments in the reply, the finality of the Office Action is improper and should be withdrawn.

**B. The Office Action Relies upon New Grounds of Rejection NOT
Necessitated by Applicants Amendments**

MPEP 706.07(a) states:

a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art ... of any claim not amended by applicants or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

As acknowledged on page 2 of the Office Action, the previous rejection of each of claims 1-35 based upon the combination of Moshir and Okimota was withdrawn, but is now rejected based on a new grounds of rejection made in view of O'Toole et al. US Patent 6,345,294. In making the present Office Action final, page 7 of the Office Action asserts that Applicants amendment necessitated the new grounds of rejection. However, this is not true.

The Office Action rejected claim 8 based upon a new ground of rejection relying upon O' Toole. However, the only amendment to claim 8 was the incorporation of the limitations of former dependent claim 9 which was canceled. Thus, claim 8 simply constituted claim 9 rewritten in independent form. This amendment to claim 8 did not necessitate a new ground of rejection.

Likewise, the Office Action rejected claim 14 based upon a new ground of rejection relying upon O' Toole. However, the only amendment to claim 14 was the incorporation of the limitations of former dependent claim 17 which was canceled. Thus, claim 14 simply constituted claim 17 rewritten in independent form. This amendment to claim 14 did not necessitate a new ground of rejection.

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Yet once again, the Office Action rejected claim 21 based upon a new grounds of rejection relying upon O' Toole. However, the only amendment to claim 21 was the incorporation of the limitations of former dependent claim 24 which was canceled. Thus, claim 21 simply constituted claim 24 rewritten in independent form. This amendment to claim 21 did not necessitate a new ground of rejection. Accordingly, the finality of the Office Action should be withdrawn for this additional reason.

II. Rejection of Claims 1-35 Under 35 U.S.C. § 103 Based Upon Moshir and O' Toole.

Pages 2-6 of the Office Action rejected Claims 1-35 under 35 U.S.C. § 103(a) as being unpatentable over Moshir et al., U.S. Patent Publication No. 20020100036, in view of O' Toole et al., U.S. Patent No. 6,345,294. For the reasons which follow, the rejection of claims 1-8, 10-16, 18-23 and 25-35 based upon Moshir in view of O' Toole should be withdrawn.

A. Claim 1

Claim 1, as amended, recites a method of configuring a hard copy output engine. The method includes receiving an electronic message including hard copy output engine configuration data from an undesignated web site through a firewall and configuring the hard copy output engine using the configuration data. The data transmitted through the firewall designates a hard copy output engine to be configured.

Neither Moshir nor O' Toole, alone or in combination, disclose or suggest transmission of an e-mail which includes output engine configuration data and that further specifies or designates a particular hardcopy output engine to be configured by the data. As acknowledged by the Office Action, Moshir fails to teach configuring a hardcopy output engine using configuration data. As a result, the Office Action attempts to additionally rely upon O' Toole. However, like Moshir, O' Toole also fails

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to disclose transmitting an e-mail including output engine configuration data that specifies or designates a particular hardcopy output engine to be configured by the data. In contrast, O' Toole merely discloses a "self-organizing distributed appliance" (SODA). As specifically described by O' Toole, SODAs are:

inexpensive special-purpose devices that serve video and other content (e.g. music, HTML pages, PDF files, etc.) and coordinate with other SODA appliances to bring video and other content as close to users as possible. The performance of AT appliances is important, because they store and retrieve video. In order to support many clients per appliance, these operations have to be performed efficiently. In the implementation described below, SODA appliances are inexpensive PCs running the Linux operating system.

(O' Toole, column 5, lines 48-57). Thus, neither Moshir nor O' Toole disclose a hardcopy output engine. Rather, both Moshir and O' Toole disclose PCs. Neither Moshir nor O' Toole disclose configuring a hardcopy output engine using configuration data received as part of an electronic message from an undesignated website through a firewall.

Failing to recognize this explicit definition of a SODA in O' Toole, the Office Action incorrectly asserts that O' Toole discloses configuring a hardcopy output engine and points to several citations in O' Toole. However, closer inspection of such citations reveals that none of them describe configuring a hardcopy output engine with configuration data received as part of an electronic message from an undesignated website through a firewall. In fact, the only mention of a "printer" in O' Toole occurs in the Background section of O' Toole which simply describes the general process by which printers or photocopying machines are configured by a person using an LCD panel and buttons. Nowhere does O' Toole even suggest that its teachings may be applied to a printer. Accordingly, the rejection of claim 1 should be withdrawn. Claims 2-7 depend from claim 1 and overcome the rejection for the same reasons.

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B. Claims 2, 8, 15, 20, 22 and 35

Claims 2, 8, 15, 20, 22 and 35, as amended, each recite configuring the hardcopy output engine via an embedded web server contained in the hardcopy output engine using the configuration data.

Neither Moshir nor O' Toole, alone or in combination, disclose the use of an embedded web server contained in the hardcopy output engine to configure the hardcopy output engine using the configuration data. Once again, as acknowledged in the Office Action, Moshir fails to disclose configuring a hardcopy output engine. As a result, the Office Action attempts to additionally rely upon O' Toole. In rejecting the claim 2, and the corresponding other claims, the Office Action refers to 10, line 14-26 and 33-38 and column 11, lines 1-7 of O' Toole and asserts that O' Toole discloses receiving an e-mail at a hardcopy output engine and configuring hardcopy output engine via an embedded Web server contained in the hardcopy output engine using the configuration data.. However, this characterization of O' Toole is incorrect.

As noted above with respect to claim number one, O' Toole fails to disclose a hardcopy output engine or the configuration of a hardcopy output engine using configuration data received as part of an electronic message. Furthermore, none of the citations disclose a hardcopy output engine having and in that it Web server. None of the citations disclose a hardcopy output engine receiving an e-mail. Each of the Office Action's citations to O' Toole describes the SODA appliance as sending, not receiving an e-mail. Thus, claims 2, 8, 15, 20, 22 and 35 overcome the rejection based upon Moshir and O' Toole. Claims 10-13 depend from claim 8 and overcome the rejection for the same reasons.

C. Claims 4, 11, 14, 21 and 29

Claims 4, 11, 14, 21 and 29, as amended, each recite receiving an e-mail through the firewall at a first user station or transmitting the electronic message to a

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user station (claim 29) and further forwarding the e-mail or electronic message to the hardcopy output engine.

Neither Moshir nor O' Toole, alone or in combination, disclose or suggest receiving the e-mail or the electronic message including the configuration data at a user station or transmitting the electronic message or the e-mail to a user station and further forwarding the e-mail or electronic message to the hardcopy output engine. Once again, as acknowledged by the Office Action, Moshir fails to disclose any e-mail including hardcopy output engine configuration data. Despite this acknowledgment, the Office Action solely relies upon Moshir for the alleged teaching of forwarding an e-mail including hardcopy output configuration data to the hardcopy output engine. Such reliance appears to be completely misplaced as (1) the Office Action itself acknowledges that Moshir fails to disclose any e-mail including hardcopy output configuration data and (2) that portion of Moshir cited by the Office Action, Paragraph [0052], says nothing about forwarding an e-mail to a hardcopy output engine. O' Toole does not satisfy the deficiencies of Moshir. Accordingly, claims 4, 11, 14, 21 and 29 overcome the rejection based on Moshir in view of O' Toole. Claims 15-16 and 18-20 depend from claim 14 and overcome the rejection for the same reasons. Claims 22-23 and a 25-26 depend from claim 21 and overcome the rejection for the same reasons.

D. Claims 5, 12, 20 and 25

Claims 5, 12, 20 and 25 each recite that the hardcopy output engine is configured via an embedded web server to set a threshold for an element chosen from a group consisting of: pigmentation material, number of hours of operation and number of sheets of print media consumed.

Neither Moshir nor O' Toole, alone or in combination, disclose configuring a hardcopy output engine via an embedded web server to set a threshold for at least one of the noted elements. As noted above with respect to the rejection of claims 2, 8, 15, 20, 22 and 35 neither Moshir nor O' Toole disclose an embedded web server.

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Moreover, neither Moshir nor O' Toole further disclose that the embedded web server is used to set a threshold for the noted elements. Once again, Moshir does not in disclose configuring a hardcopy output engine. Like Moshir, O' Toole also failed to disclose configuring a hardcopy output engine using configuration data from an electronic message. Because neither Moshir nor O' Toole disclose or even relate to configuring a hardcopy output engine, such as a printer, neither disclose a hardcopy output engine configured via an embedded web server to set a threshold for an element chosen from a group consisting of: pigmentation material, number of hours of operation and number of sheets of print media consumed. Thus, claims 5, 12, 20 and 25 overcome the rejection based upon Moshir in view of O' Toole.

E. Claim 7

Claims 7 depends from claim 1 and further recites that the configuration data is prepared by determining a make and model for the hardcopy output engine; determining a serial number for the hardcopy output engine and determining user thresholds for consumables associated with the hardcopy output engine.

Neither Moshir nor O' Toole, alone or in combination, disclose or suggest hardcopy output engine configuration data that is prepared by determining a make and model for the hardcopy output engine, a serial number for the hardcopy output engine end user thresholds for consumables associated with the hardcopy output engine. Once again, as acknowledged by the Office get action, Moshir does not even disclose hardcopy output engine configuration data. O' Toole also failed to disclose hardcopy output engine configuration data which is received as an electronic message. Nowhere does O' Toole disclose determining the noted characteristics of the hardcopy output engine when preparing configuration data or determining user's thresholds for consumables associated with the hardcopy output engine. Thus, claim 7 overcomes the rejection for this additional reason.

F. Claim 27

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Claim 27 recites a method which includes a step of forming hardcopy output engine configuration data on a first side of the firewall based upon input received from a second side of the firewall and transmitting an electronic message including the configuration data through the firewall to a hardcopy output engine on the second side of the firewall.

Neither Moshir nor O' Toole, alone or in combination, disclose or suggest the method of claim 27. As acknowledged by the Office Action, Moshir does not disclose hardcopy output engine configuration data. O' Toole also fails to disclose configuring a hardcopy output engine using configuration data received as part of an electronic message. As a result, O' Toole also does not disclose forming hardcopy output engine configuration data on a first side of the firewall based on input received from a second side of the firewall, the second side of the firewall being the same side of the firewall that includes the hardcopy output engine. Accordingly, the rejection of claim 27 is improper and should be withdrawn. Claims 28-35 depend from claim 27 and are patentably distinct over Moshir and O' Toole for the same reasons.

G. Claim 31

Claim 31 depends from claim 27 and further recites the step of transmitting an electronic message including an address of the hardcopy output engine from the second side of the firewall (i.e., the same side of the firewall that contains the hardcopy output engine) to the first side of the firewall.

Neither Moshir nor O' Toole, alone or in combination, disclose or suggest this step. In fact, for the now second time, the Office Action fails to establish even a prima facie case of obviousness in that the Office Action fails to address the limitations above claim 31 which are not found in claims 1-7. Thus, claim 31 overcome the rejection for this additional reason.

H. Claim 34

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Claim 34 depends from claimed 27 and further recites that providing the input comprises interacting with a web site on the first side of the firewall with a web browser on the second side in the firewall (the same side of the firewall as the hardcopy output engine).

Neither Moshir nor O' Toole, alone or in combination, disclose or suggest providing input to a web site on the first out of the firewall using a web browser on the same side of the firewall as the hardcopy output engine. Once again, Moshir fails to disclose hardcopy output engine configuration data. O' Toole also fails to disclose and hardcopy output engine that receives configuration data via an electronic message, wherein configuration data is formed based upon such input. Thus, the rejection of claim 34 is improper and should be withdrawn for this additional reason.

III. Conclusion.

Claims 1-8, 10-16, 18-23 and 25-35 are now pending in this application.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith,

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Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

Date Oct. 17, 2006

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